



[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No.: PTO-P-2012-0022]

Quick Path Information Disclosure Statement (QPIDS) Pilot Program

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO) is implementing a pilot program intended to reduce pendency and applicant costs when an information disclosure statement (IDS) is filed after payment of the issue fee. This pilot program will permit an examiner to consider an IDS after payment of the issue fee without the need to reopen prosecution, effectively obviating the need to pursue a request for continued examination (RCE). Where the examiner determines that no item of information in the IDS necessitates reopening prosecution, the Office will issue a corrected notice of allowability. In addition to reducing pendency, this pilot program will promote efficiency in the examination process. There will be no fee required to use this program, beyond existing fees, e.g., fees for IDS submission.

DATES: Effective Date: May 16, 2012.

Duration: The QPIDS Pilot Program will run from its effective date until September 30, 2012. Therefore, an IDS submitted under this pilot program must be filed on or before September 30, 2012. The USPTO may extend this pilot program (with or without modifications) depending on feedback from the participants and the effectiveness of the program.

FOR FURTHER INFORMATION CONTACT: Nicole D. Haines, Legal Advisor, or Raul Tamayo, Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy, by telephone at (571) 272-7717 or (571) 272-7728, respectively, or by mail addressed to: Mail Stop Comments - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

SUPPLEMENTARY INFORMATION: Applicants who become aware of information after payment of the issue fee often file RCEs to have this information considered by an examiner. This is because 37 CFR 1.97 does not provide applicants with the opportunity to file an IDS after payment of the issue fee. Thus, applicants who determine that they need to file an IDS after payment of the issue fee must either file a petition under 37 CFR 1.313(c)(2) to withdraw the application from issue in order to permit entry of an RCE and have the accompanying IDS considered by the examiner, or file a petition under 37 CFR 1.313(c)(3) to withdraw the application from issue for express abandonment in favor of a

continuing application. These applications experience delays associated with the filing and processing of the RCE (or continuing application), even if the information in the IDS would not have otherwise necessitated reopening prosecution.

In order to reduce pendency delays and costs associated with the current process for considering IDS submissions filed after payment of the issue fee, IDS submissions made in accordance with this pilot program will be considered by the examiner before determining whether prosecution should be reopened. Under this pilot program, prosecution will only be reopened where the examiner determines that reopening prosecution is necessary to address an item of information in the IDS. When the items of information in the IDS do not require prosecution to be reopened, the application will pass to issue, thereby eliminating the delays and costs associated with RCE practice.

A. QPIDS Pilot Program Requirements

In order to be eligible to participate in this pilot program, an application must be a utility or reissue application (i.e., this pilot program does not pertain to design or plant applications). In addition, as set forth in detail below, a QPIDS submission must include the following items: (1) a transmittal form that designates the submission as a QPIDS submission, such as form PTO/SB/09; (2) an IDS accompanied by a timeliness statement set forth in 37 CFR 1.97(e), with the IDS fee set forth in 37 CFR 1.17(p); (3) a Web-based ePetition to withdraw from issue under 37 CFR 1.313(c)(2), with the petition fee set forth in 37 CFR 1.17(h); and (4) an RCE, which will be treated as a “conditional” RCE, with the RCE fee under 37 CFR 1.17(e). All papers associated with this pilot

program must be filed via the USPTO's Electronic Filing System-Web (EFS-Web), and all fees must be paid by authorization to charge a deposit account.

1. Transmittal Form

A new transmittal form, PTO/SB/09, has been made available at <http://www.uspto.gov/forms/index.jsp> to identify submissions made pursuant to this pilot program. Use of this form will help the Office to quickly identify QPIDS submissions and facilitate timely processing of such submissions. The Office of Management and Budget (OMB) has determined that, under 5 CFR 1320.3(h), Form PTO/SB/09 does not collect "information" within the meaning of the Paperwork Reduction Act of 1995.

2. IDS with Timeliness Statement and Fee

A submission under this pilot program must include an IDS in accordance with 37 CFR 1.97 and 37 CFR 1.98. Because 37 CFR 1.97(d) does not provide for the filing of an IDS submission after payment of the issue fee, the USPTO is sua sponte waiving 37 CFR 1.97(d) for IDS submissions filed under this pilot program to the extent that IDS submissions pursuant to this pilot program may be filed after payment of the issue fee. However, the requirements of 37 CFR 1.97(d)(1) and (d)(2) that the IDS be accompanied by a timeliness statement specified in 37 CFR 1.97(e) and the fee set forth in 37 CFR 1.17(p) are not waived.

IDS submissions made under this pilot program must be accompanied by either the timeliness statement set forth in 37 CFR 1.97(e)(1) or the timeliness statement set forth in

37 CFR 1.97(e)(2). The QPIDS transmittal form PTO/SB/09 provides the appropriate timeliness statements for selection by applicant. Additionally, the IDS submission must include the IDS fee set forth in 37 CFR 1.17(p), by including an authorization to charge a deposit account. The QPIDS transmittal form PTO/SB/09 provides an authorization to charge a deposit account for payment of the IDS fee. A submission that provides for payment of the IDS fee (or any other required fee) via a fee transmittal form authorizing another form of payment does not comply with the requirements of this pilot program. Thus, applicants must have an established USPTO deposit account to participate in this pilot program. Information on USPTO deposit accounts is available at http://www.uspto.gov/about/offices/cfo/finance/Dep_Account_Rules_and_Info.jsp.

3. Web-based ePetition and Fee

A submission under this pilot program must be filed with a “Petition to Withdraw from Issue After Payment of the Issue Fee” (37 CFR 1.313(c)(2)) submitted as a Web-based ePetition via EFS-Web with the petition fee set forth in 37 CFR 1.17(h). Information regarding submission of Web-based ePetitions is available at <http://www.uspto.gov/patents/process/file/efs/guidance/epetition-info.jsp>. Depending on whether a patent number has been assigned, applicants must select either the “Petition to Withdraw from Issue after Payment of the Issue Fee (37 CFR 1.313(c)(1) or (2))” or the “Petition to Withdraw from Issue after Payment of the Issue Fee (37 CFR 1.313(c)(1) or (2) with Assigned Patent Number).” The RCE that accompanies a QPIDS submission under this pilot program will be deemed sufficient to satisfy the requirement in 37 CFR 1.313(c)(2) that the petition to withdraw from issue is for consideration of an RCE in

compliance with 37 CFR 1.114, even though the RCE will only be processed if the examiner determines that any item of information in the IDS necessitates reopening prosecution.

4. RCE and Fee

A submission under this pilot program must include an RCE, with the IDS meeting the submission requirement for the RCE. The RCE will be treated as a “conditional” RCE until the examiner determines whether any item of information in the IDS necessitates reopening prosecution. Additionally, the QPIDS submission must be accompanied by the RCE fee under 37 CFR 1.17(e) in order to process the ePetition to withdraw the application from issue under 37 CFR 1.313(c)(2).

Under this pilot program, the RCE will be processed and treated as an RCE under 37 CFR 1.114 in the event the examiner determines that any item of information contained in the IDS necessitates the reopening of prosecution in the application. In this instance, the IDS fee under 37 CFR 1.17(p) will be automatically returned because the IDS complies with 37 CFR 1.97(b)(4). Otherwise, if the examiner determines that no item of information in the IDS necessitates reopening prosecution, the RCE will not be processed and the RCE fee will be automatically returned. This will save applicants both the time and costs associated with RCE practice. An RCE filed pursuant to this pilot program complies with the timing requirement of 37 CFR 1.114(a)(1). This pilot program is an exception to the provision in MPEP 706.07(h), which provides that the Office will treat a “conditional” RCE as if an RCE had been filed. Otherwise, the Office

generally treats conditional requests without regard to the “conditional” designation (see, e.g., MPEP 201.06(d), MPEP 706.07(g), and MPEP 714.13).

B. Processing of QPIDS Pilot Program Submissions: A compliant ePetition to withdraw the application from issue, pursuant to 37 CFR 1.313(c)(2), will be granted immediately upon submission. After the grant of such a petition, the IDS submission made under this pilot program will be identified and placed on the examiner’s “expedited” docket for consideration. If the examiner determines that no item of information in the IDS necessitates reopening prosecution, the examiner will issue a corrected notice of allowability (i.e., form PTOL-37). The corrected notice of allowability will identify the IDS and be accompanied by a copy of the submitted IDS listing (e.g., form PTO/SB/08) as considered by the examiner. See MPEP 609.05(b). Considered information will be printed on the patent pursuant to MPEP 609.06. No applicant response to the corrected notice of allowability will be necessary. In this instance, the RCE will not be processed and the RCE fee will be automatically returned by the Office (the IDS and petition fees will not be returned). In this instance, where the examiner has determined that prosecution does not need to be reopened, a new notice of allowance and fee(s) due (i.e., PTOL-85) will not be issued. To the extent provisions of 37 CFR 1.313(a) are not consistent with this pilot program, such provisions are hereby waived for QPIDS pilot program submissions.

If the examiner determines that any item of information in the IDS necessitates reopening prosecution, the RCE will be processed and placed on the examiner’s docket. In this

instance, the RCE will be deemed filed as of the filing date of the QPIDS submission, and the IDS fee will be automatically returned by the Office because the IDS complies with 37 CFR 1.97(b)(4) (the petition fee will not be returned). The applicant will be notified that prosecution is being reopened (via a form PTO-2300), and such notification will identify the IDS and be accompanied by a copy of the submitted IDS listing (e.g., form PTO/SB/08) as considered by the examiner. See MPEP 609.05(b). If the application is subsequently again found allowable, the applicant may request that the previously paid issue fee be reapplied toward the issue fee that is now due in the same application. See MPEP 1306.

A non-compliant QPIDS submission that otherwise complies with the requirements of 37 CFR 1.114 will be treated as an RCE. For example, failure to provide an authorization to charge a deposit account for payment of the IDS fee or failure to select or otherwise provide an appropriate timeliness statement will result in the RCE being processed. Similarly, a submission under this pilot program that includes an amendment will be processed as an RCE.

Taking post-issue fee payment processing times into consideration, applicants are strongly encouraged to file IDS submissions under this pilot program as soon as the applicants become aware that it is necessary to submit an IDS. Applicants are reminded, where applicable, to include a statement under 37 CFR 1.704(d) so as to avoid reduction in patent term adjustment pursuant to 37 CFR 1.704(c)(10). See, [Revision of Patent](#)

Term Adjustment Provisions Relating to Information Disclosure Statements, 76 Fed.
Reg. 74700, 74701 (December 1, 2011) (final rule).

Additional information regarding this pilot program will be made available on the
USPTO's Web site at http://www.uspto.gov/patents/init_events/qpids.jsp.

Date: __ May 3, 2012 __

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

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